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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/536,861	03/27/2000	Tibor Juhasz	11236.11MKH	3826
26271	7590	03/07/2005	EXAMINER	
FULBRIGHT & JAWORSKI, LLP 1301 MCKINNEY SUITE 5100 HOUSTON, TX 77010-3095			SHAY, DAVID M	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/536,861

Applicant(s)

JUHASZ ET AL.

Examiner

david shay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on June 15, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date June 15, 2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filed does not provide support for the invention as now claimed. Specifically there is no disclosure of an “optimized pulse energy density above a minimum level” either expressly, by incorporation, or by inference in the originally filed disclosure, nor is the particular density claimed so supported.

Firstly it is noted that the only reference to energy density in the entirety of the originally filed specification is “a fluence of less than 100 joules per square centimeter.” this maximum allowable quantity cannot be cast in the context of a “minimum level” (above which the optimized pulse energy density is set). Secondly, it is noted the U.S. Patent 4,764,930 to Bille et al, which is referenced in applicants remarks and also on page 6 of the originally filed disclosure refers to optimization of parameters only in the vaguest terms (see column 1, lines 31-51) and makes no reference to an “optimized pulse energy density above a minimum level.”

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 12-17, 22, 24-36, 39, and 40 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Ito et al.

Ito et al teach formation of a “lens shaped” lenticle to be removed from the cornea the 20 micron diameter spots at 40 and 60 microjoules are above the claimed minimum pulse energy density, various (concave, convex, spiral, circular) shapes are disclosed in wither aplanated or non-aplanated configuration (see text starting at the first full paragraph in column 1 of page 723 to the end of the first full paragraph at column 1 of page 727.

Claims 24-37 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swinger et al in combination with Stern et al. Swinger teaches a method as claimed except the energy density discussed in the claims. Stern et al teach the desirability of employing pulse energies above the minimum ablation threshold. It would have been obvious to the artisan of ordinary skill to employ the energy densities of Stern et al in the method of Swinger et al, since this removes tissue in a plasma regime, which yields increasing depth as pulse energy increases (see Fig 1 of Stern) or to employ the ablation configuration of Swinger et al in the method of Stern et al, since this yields efficacious optical corrections, and in either case, to form the flap as an oval, since this would leave undisturbed a larger amount of tissue in the case of an astigmatic ablation, thus producing a method such as claimed).

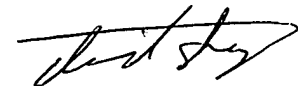
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Claims 12-20, 22, 23, 38, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swinger et al in combination with Stern et al as applied to claims 24-37 and 40 above, and further in combination with Warner et al. Warner et al teach the equivalence of forming cap and forming a flap. It would have been obvious to the artisan of ordinary skill to form a flap in the method of Swinger et al since these are equivalents, as shown by Warner et al and because the accurate replacement of a flap is more easily achieved than with a cap, official notice of which is hereby taken, thus producing a method such as claimed.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swinger et al in combination with Stern et al and Warner et al as applied to claims 12-20, 22, 23 and 39 above, and further in combination with Bronstein. Bronstein teaches forming an interlocking feature, which can take the form of a tab to affix an implant to the cornea. It would have been obvious to take artisan of ordinary skill to form a structure as taught by Bornstein on the flap of Warner et al since this would help affix the flap in placing during healing.

Applicant's arguments with respect to claims 12-40 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication should be directed to david shay at telephone number 571-272-4773.



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